

S/N 10/038,766  
Ref. No.: 659-919

## REMARKS

In an Office Action mailed April 8, 2004, the Examiner rejected independent claim 1 as being anticipated by U.S. Patent No. 5,025,910 to Lasure, independent claim 9 as being anticipated by U.S. Patent No. 6,482,278 to McCabe, independent claim 15 as being anticipated by U.S. Patent No. 4,943,340 to Ujimoto and independent claim 17 as being anticipated by U.S. Patent No. 4,578,133 to Oschefsky. Because Lasure, McCabe, Ujimoto and Oschefsky fail to disclose or suggest all of the recitations of the pending claims, inherently or otherwise, the Examiner's rejections should be withdrawn.

Applicants gratefully acknowledge the Examiner's statement that claim 3 would be allowed if rewritten in independent form. Applicants have amended claim 3 by rewriting it in independent form. Accordingly, claim 3 is in condition for allowance.

### Claim 1:

Applicants have amended claim 1 to recite that the recessed portion, which is formed *as part of the outer surface*, has a "bottom surface," which is adapted to and configured to engage at least one portion of a discrete part. In contrast, the vacuum holes 54 of Lasure do not have a *bottom* surface formed in the outer surface of the shoe 33. Indeed, the very nature of the vacuum holes in Lasure requires that they pass *through the outer surface of the shoe*, such that they can supply the vacuum air supply. As such, the holes are completely devoid of any bottom surface formed in the outer surface of the shoe. Accordingly, Lasure does not disclose or suggest all of the limitations of claim 1 and the Examiner's rejections should therefore be withdrawn.

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**Claim 9:**

Applicants have amended claim 9 to recite that the said outer surface includes “at least one recessed portion *having a bottom surface* for engaging at least one portion of the discrete part that is relatively thicker than other portions of the discrete part.” As explained above with respect to claim 1, holes formed in a vacuum head 44, as disclosed in McCabe, do have a bottom surface formed on the outer surface. Accordingly, claim 9 is allowable over McCabe for the same reasons set forth above with respect to claim 1.

**Claim 15:**

Claim 15 recites that the outer surface of the web conveyor includes “at least one recessed portion *having a bottom surface* for engaging at least one portion of each of the discrete parts that is relatively thicker than other portions of each of the discrete parts.” In the outstanding Office Action, the Examiner has asserted that the conveyor belts 21a, 21b are spaced, thereby forming a “recess” therebetween. Applicants respectfully disagree.

First, claim 15 recites that the recessed portion has a “bottom surface.” Accordingly, to the extent that the Examiner is applying the unsupported span of belts 21a, 21b between the rolls 19, 20 as the web conveyor, any recessed portion defined therebetween does not have a “bottom surface,” but rather is merely an open space.

Alternatively, to the extent that the Examiner is applying the outer surface of one of the rolls 19, 20 as the recessed portion having a bottom surface, Applicants note that the belts 21a, 21b are disposed in grooves 19A, 19B, 20A, 20B formed in each of the rolls 19, 20, with the belts lying flush with the outer surface of the rolls (Col. 5, lines 23-28; FIGS. 3-5). Accordingly, the outer surfaces of the rolls 19, 20 are not “recessed” with respect to the belts 21a, 21b, but rather are flush therewith.

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For these reasons, Ujimoto fails to disclose all of the limitations of claim 15 and the Examiner's rejection should be withdrawn.

**Claim 17:**

Claim 17 recites that the outer surface includes "at least one recessed portion *having a bottom surface* for engaging at least one portion of the discrete parts that is relatively thicker than other portions of the discrete parts." As explained above with respect to the other claims, vacuum holes do not have bottom surfaces formed in the outer surface of a transfer member 30, as disclosed in Oschefsky. For at least this reason, Oschefsky fails to disclose all of the limitations of claim 17 and the Examiner's rejection should be withdrawn.

**NEW CLAIMS:**

Applicants have submitted new claims 22 and 23 to further define the invention. Support for these claims is found throughout the specification and drawings. No new matter has been added.

New claim 22 recites that the "recessed portion has an aperture opening into said bottom surface thereof." In this way, claim 22 further differentiates the vacuum holes disclosed in McCabe and applied as the recess by the Examiner.

New claim 23 recites "at least one aperture in said recessed portion of said outer surface and extending through said carrier body for communication with a vacuum source, said at least one aperture having a cross-sectional area and said recessed portion having a surface area, wherein said surface area is greater than said cross-sectional area." In this way, claim 23 further differentiates between the various devices having vacuum holes formed therein.

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**CONCLUSION:**

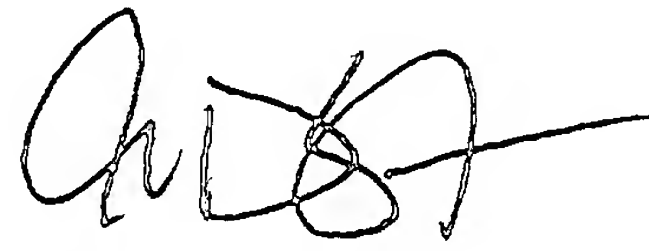
After Amendment, this application has twenty-one (21) claims, including six (6) independent claims. Applicants previously paid for twenty (20) claims including four (4) independent claims. Accordingly, Applicants have enclosed a check in the amount of \$190 for the additional claims fee. Any additional fees or overpayments associated with this Response should be charged or credited respectively to Deposit Account No. 23-1925.

If for any reason this application is not considered to be in condition for allowance and an interview would be helpful to resolve any remaining issues, the Examiner is respectfully requested to call the undersigned attorney at (312) 321-4713.

Respectfully Submitted,

Dated: July 7, 2004

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